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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,407	12/16/2003	Richard Wade Hochanadel	3372	7614
37761	7590	11/18/2005	EXAMINER	
ERICKSON & KLEYPAS, L.L.C. 800 W. 47TH STREET, SUITE 401 KANSAS CITY, MO 64112			SPISICH, MARK	
			ART UNIT	PAPER NUMBER

1744

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

Office Action Summary	Application No. 10/737,407	Applicant(s) HOCHANADEL, RICHARD WADE	
	Examiner Mark Spisich	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-11 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of the invention of Group I (the applicator) in the reply filed on 12 September 2005 is acknowledged. The traversal is on the ground(s) that the process can not be practiced by another, materially different apparatus. This is not found persuasive because the STRUCTURE required by EACH of the independent apparatus claims (1,9 and 10) defines the structure of the applicator in a manner which is different than that required by the method claim (12). The fact that there is a difference in the structure required by these claims is evidence to support the assertion that the process can be practiced by another and materially different apparatus. In addition, the device as CLAIMED in claim 1 could even include an integral gripping means and NOT a separate gripping means (which would be implied by the step of attaching such a grip to the applicator after it is separated). Further, the apparatus claims need not be used to practice the same process as recited in claim 12.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Forbis (USP 2,261,058). The patent to Forbis discloses a device comprising two sections (6,8) which have a weakened area (9) between them to permit the severing

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thereof (column 1, lines 43-48) and wherein one of the sections (8) including a porous absorbent filamentary material (7) (column 1, lines 38-40) covering a substantial portion thereof. Once severed, the exposed portion of segment (8) would provide a means for gripping the applicator. The structure shown in figure 1 of Forbis is, in its entirety, the recited elongated handle divided into a gripping portion (6) and an applicator portion (8). The portion (8), once severed, is perfectly capable of being gripped by the user and used independently of the remaining portion and would thus constitute a means for gripping after it is separated.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4,5,7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forbis (USP 2,261,058). The patent to Forbis discloses the invention substantially as claimed with the exception of the material of the pad or specifying the material of the handle. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

5. Claims 9-11 are allowed.

Response to Arguments

6. Applicant's arguments filed 12 September 2005 have been fully considered but they are not persuasive. It is the STRUCTURE of the claims, and not use or mode of operation thereof, which must serve to distinguish a claimed apparatus from that of the prior art. The structure of Forbis (USP 2,261,058) discloses an elongated handle (5) which includes a zone of fracture (9) between the ends thereof so as to define the handle into a gripping portion (6) and an applicator portion (8) whereby the portion (8) may be removed from the remaining portion about the zone of fracture. The portion (8) of Forbis, once removed, is perfectly capable of being grasped by the user and would thus constitute a "means for gripping". Applicant is arguing the difference between the mode of operation or intended use of the claimed applicator and that of the prior art as opposed to differences in the structure of the claim(s) and that of the prior art.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Spisich
Primary Examiner
Art Unit 1744

MS